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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,425	08/25/2003	John McFarland Harris	CE09293R	2796

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EXAMINER	
CHURNET, DARGAYE H	
ART UNIT	**PAPER NUMBER**
2616	

NOTIFICATION DATE	DELIVERY MODE
09/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/647,425	HARRIS ET AL.	
	Examiner	Art Unit	
	Dargaye H. Churnet	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 August 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 7, 8, 13-15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (cited 6,728,365 B1).

For claim 1, Li et al. disclose a method for transmitting information from a sender at a source mobile unit to a recipient at a destination mobile unit, the method comprising: selecting the destination mobile unit (see col. 6, lines 21-25, wherein MT 16 is the source mobile unit, and second terminal 18 is the destination mobile unit); forming an overture element, the overture element containing information from the sender at the source mobile unit indicating that the sender desires to establish a wireless connection with the recipient at the destination mobile unit (see col. 4, lines 25-30, wherein the PATH message initiates communication between the source and destination in the wireless network); forming at least one data burst message incorporating the overture element (see col. 8, lines 56-58, wherein data bursts are sent as PATH messages); and transmitting the at least one data burst message including the

overture element over the wireless connection between the source mobile unit and the destination mobile unit (see col. 17, lines 44-49, wherein data bursts are transmitted to initiate a traffic channel). Claims 8 and 14 are rejected for similar reasons.

For claim 3, Li et al. disclose receiving the data burst message at the destination mobile unit; extracting the overture element from the at least one data burst message; and evaluating the information in the overture element; and determining whether to establish the wireless connection based upon the information in the overture element (see col. 11, lines 51-63, wherein either PATH messages or data bursts may be sent to the receiver 18, and upon receipt, the receiver sends a RESV message to satisfy communication quality).

For claim 7, Li et al. disclose forming the at least one data burst message comprises forming two or more data burst messages (see col. 8, lines 56-58, wherein short data bursts are transmitted, meaning two or more data burst messages). Claims 13 and 15 are rejected for similar reasons.

For claim 17, Li et al. disclose the wireless telecommunication infrastructure transmitting the data burst message according to the CDMA 2000 protocol (see col. 6, lines 6-9, wherein cdma2000 protocol is used).

For claim 18, Li et al. disclose the destination mobile unit operates in a plurality of call-processing states and sub-states, at least one of which is a waiting for order sub-state, and the destination mobile unit is operating in the waiting for order sub-state during the receipt of the at least one data burst message (see col. 8, lines 19-24, wherein there are many different states and the waiting for order sub-state is represented by the dormant state).

Claim Rejections - 35 USC § 103

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Valentine et al. (cited 6,088,589).

For claim 4, Li et al. fail to disclose the forming the overture element comprising forming a voice message. Valentine et al. from the same or similar fields of endeavor teach the forming the overture element comprising forming a voice message (see col. 10, lines 18-19, wherein a voice message is played). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. is modified/implemented into the network of Li et al. by playing a voice message. The motivation for the forming the overture element comprising forming a voice message is to distinguish the source mobile unit to the destination mobile terminal. Claim 9 is rejected for similar reasons.

For claim 5, Li et al. fail to disclose the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response. Valentine et al. from the same or similar fields of endeavor teach the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response (see col. 10, lines 16-25, wherein a mobile station plays a voice message to a destination in regards to establishing a connection between the two). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. is modified/implemented into the network of Li et al. by sending a voice message from the source to the destination. The motivation for the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response is to establish a wireless connection. Claim 10 is rejected for similar reasons.

For claim 6, Li et al. fail to disclose establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient

determines to establish the wireless connection. Valentine et al. from the same or similar fields of endeavor teach establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection (see col. 8, lines 16-19, wherein a call is placed only if the destination accepts it). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. is modified/implemented into the network of Li et al. by waiting for a response from the destination. The motivation for establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection is to have both parties available for the call.

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Valentine et al. as applied to claims 4-10 above, and further in view of Schmidt (cited 6,018,668).

For claim 11, Li et al. in view of Valentine et al. fail to disclose muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit. Schmidt from the same or similar fields of endeavor teaches muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit (see col. 3, lines 4-7, wherein the mobile station mutes a

microphone). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Schmidt in the network of Li et al. in view of Valentine et al. The method taught by Schmidt is modified/implemented into the network of Li et al. in view of Valentine et al. by muting a microphone. The motivation for muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit is to stop listening to the voice message.

For claim 12, Li et al. fail to disclose establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection. Valentine et al. from the same or similar fields of endeavor teach establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection (see col. 8, lines 16-19, wherein a call is placed only if the destination accepts it). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. is modified/implemented into the network of Li et al. by waiting for a response from the destination. The motivation for establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection is to have both parties available for the call.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Schmidt.

For claim 16, Li et al. fail to disclose muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit. Schmidt from the same or similar fields of endeavor teaches muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit (see col. 3, lines 4-7, wherein the mobile station mutes a microphone). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Schmidt in the network of Li et al. The method taught by Schmidt is modified/implemented into the network of Li et al. by muting a microphone. The motivation for muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit is to stop listening to the voice message.

Response to Arguments

7. Applicant's arguments along with amendments to the claims have been fully considered, but are not persuasive. The addition of essentially all of what was formerly claim 2 into claims 1, 8, and 14 do not make the claims allowable as claim 2 was also previously rejected under Li et al. wherein data bursts are used to initiate a wireless traffic channel. Therefore, the rejections stand.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dargaye H. Churnet whose telephone number is 571-270-1417. The examiner can normally be reached on Monday-Friday from 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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